

REMARKS/ARGUMENTS

Applicants' attorneys respectfully request reconsideration and withdrawal of the rejections of the application in view of the above amendments and following remarks, which place the application into condition for allowance.

The instant After-Final Amendment is being made to facilitate prosecution of the application and does not require a further search. Therefore, Applicants' attorneys respectfully request that the instant Amendment be entered.

I. STATUS OF THE CLAIMS AND RECORD OF TELEPHONE INTERVIEW

Claims 1-14, 16, 17, 19-34 and 36-40 are pending in this application. Claims 5-6, 25 and 26 have been withdrawn from consideration and claims 15, 18 and 35 have been canceled. In the Office Action mailed August 21, 2006, claims 1-4, 7-14, 16, 17, 19-24, 27-34 and 36-40 are rejected. By this Amendment, claims 1 and 24 are amended and claim 21 is canceled without prejudice to its subsequent prosecution in any continuing application or disclaimer of the proprietary rights set forth therein. Support for the claim amendments can be found throughout the specification, see for example, paragraph [0010]. It is believed that no new subject matter is added as a result of the claim amendments.

Initially, the Examiner is thanked for granting Applicants' attorneys an in person interview on November 28, 2006. Participants in the interview included Examiner Piziali, and Applicants' representatives R. Santucci and A. Mustillo. The Final Office Action mailed on August 21, 2006 and cited references U.S. Patent No. 6,432,850 to Takagi ("Takagi") and U.S. Patent No. 5,744,236 to Rohrbach et al. ("Rohrbach"), were discussed in detail. In addition, possible claim amendments were discussed and the fact that the instant invention is directed to

engineered fabrics while Takagi is directed to conductive clothing and Rohrbach is directed to filter media. An agreement with respect to the claims was not reached.

II. THE REJECTIONS UNDER 35 U.S.C. § 103(a)

In numbered paragraph 3 of the Office Action, claims 1-4, 7-8, 11-14, 16, 17, 19-22, 24, 27, 28, 31-34, 36, 37, 39 40 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takagi in view of Rohrbach. In numbered paragraph 4 of the Office Action, claims 9, 10, 23, 29, 30 and 38 are rejected under § 103(a) as allegedly being unpatentable over Takagi in view of Rohrbach and further in view of U.S. Patent No. 4,803,096 to Kuhn et al. ("Kuhn"). The rejections are traversed for at least the following reasons.

As recited in revised independent claims 1 and 24, the instant invention is directed to engineered fabrics used in making nonwoven textiles in the airlaid, meltblown or spunbonding processes and the filaments that are used to construct these engineered fabrics. In contrast, Takagi is directed to fabrics excellent in conductivity and antistatic property as well as dust proof clothes sewed therefore, which are electroconductive throughout the dust proof clothes, *Takagi*, col. 1, lines 6-10, and Rohrbach is directed to nonwoven filter media. *Rohrbach*, Abstract.

As discussed above, the instant claims are specifically limited to engineered fabrics. More particularly, engineered fabrics and filaments used in engineered fabrics used in making nonwoven textiles in the airlaid, meltblown or spunbonding processes. Engineered fabrics are very specific in their use and are used in industrial applications on large machines and in harsh, adverse conditions. Engineered fabrics are not dust proof clothing as is the case with Takagi or filter media as is the case with Rohrbach, both of which are subject to less strenuous conditions and applications than engineered fabrics. A skilled worker would not look to clothing or filter

media as applicable to the field of engineered fabrics. This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

This situation is analogous to that in *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). In that case the court held that the use of the term "optical waveguide" did not merely state a purpose or intended use. Rather, it gave "life and meaning" to the claim and provided a further positive limitation to the invention claimed. The court, in making its determination, looked to the entire patent to determine and gain an understanding as to what the inventors actually invented and intended to encompass by the claim. The court noted that "[t]o read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality."

So to here, to read the claim language to cover all types of fabrics would be divorced from reality. It is clear from the specification that the invention is directed towards engineered fabrics. The environments in which engineered fabrics are used are much harsher and therefore require more durable fabrics than fabrics used in clothing or for filter media. Engineered fabrics must be able to withstand the ravages of the industrial machinery on which they are used. Accordingly, a skilled worker would not look to fabrics for use in an article of clothing or fibers for use in filter media as being applicable to engineered fabrics. This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

Accordingly, just as in *Sumitomo*, the Takagi and Rohrbach references do not have the limitation of an engineered fabric used in making nonwoven textiles in the airlaid, meltblown or spunbonding processes.

Applicants' attorneys also respectfully remind the Examiner that in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary

incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992), "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the § 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988).

Applying the law to the instant facts, Applicants' attorneys submit that because Takagi, Rohrbach and Kuhn fail, either alone or in combination, to teach, suggest or motivate a skilled artisan to practice the instantly claimed invention, the § 103 rejections must fail. Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. As "obvious to try" would be the only basis by which the obviousness rejection could stand and because there is no motivation found in the cited references to combine or modify the cited references in the manner suggested by the Examiner, it is respectfully submitted that the § 103 rejections must fail as a matter of law for this reason as well.

In view of the above, it is respectfully submitted that the pending claims are not rendered obvious over Takagi, Rohrbach and Kuhn.

For at least the foregoing reasons, Applicants' attorneys respectfully submit that revised independent claims 1 and 24 patentably distinguish over Takagi, Rohrbach and Kuhn, either alone or in combination because the relied upon portions of the cited references fail to teach each

and every limitation of revised claims 1 and 24 or motivate a person skilled in the art to modify or combine the references to practice the claimed invention. Therefore, claims 1 and 24 are allowable. Further, claims 2-4, 7-14, 16, 17, 19-23 and 39, which depend from claim 1, and claims 27-34, 36-38 and 40, which depend from claim 24, are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

CONCLUSION

In view of the foregoing, it is submitted that the instant claims should be allowed and that the instant application is now in condition for allowance. It is further submitted that this After-Final Amendment does not require an additional search. Therefore, Applicants' attorneys respectfully request entry of this After-Final Amendment and favorable reconsideration of the application, withdrawal of the rejections, and prompt issuance of the Notice of Allowance.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By:

Anthony D. Mustillo
Ronald R. Santucci
Reg. No. 28,988
Anthony D. Mustillo
Reg. No. 58,836
Telephone: (212) 588-0800
Facsimile: (212) 588-0500